

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN H. BRENNAN
GREGORY P. DILLON,
ELMIRA HEIGHTS,
TUDOR C. GHEORGHIU and
MICHAEL J. VAYANSKY

Appeal 2006-3301
Application 10/606,509
Technology Center 1700

Decided: January 24, 2007

Before PETER F. KRATZ, CATHERINE Q. TIMM, and LINDA M.
GAUDETTE, *Administrative Patent Judges*.

KRATZ, *Administrative Patent Judge*.

ORDER REMANDING TO THE EXAMINER

This appeal involves claims 1, 2, 4-6, 8-11, 15-20, and 22-27. We remand the application to the Examiner for consideration and explanation of issues raised by the record. 37 C.F.R. §§ 41.35(b) and 41.50(a)(1). In particular, we remand this application to the Examiner to consider the

Substitute Brief on Appeal filed on June 16, 2006 for entry and, if entered, to furnish an appropriate response to the Substitute Brief on Appeal. We note that the Substitute Brief on Appeal was filed after the Examiner's Answer dated April 12, 2006 was issued and the application file record does not reflect that the Examiner responded thereto.

Moreover, we observe that the Examiner presents a rebuttal argument in the Answer seemingly implying that a 35 U.S.C. § 112, first paragraph issue is present from the perspective of the Examiner (Answer 7). However, a 35 U.S.C. § 112, first paragraph rejection has not been presented in the Answer. Also, the Answer does not include a full statement of the Examiner's position setting forth how the teachings of the applied references would have rendered the rejected claims obvious to one of ordinary skill in the art in accordance with MPEP § 1207.02 (Rev. 3, August 2005). *See* Answer at p. 3.

The Examiner should submit a Supplemental or Substitute Answer clarifying the record to clearly reflect that only an obviousness issue remains to be considered with respect to the claimed subject matter on appeal if such is the case, present a complete statement of the obviousness rejection in accordance with MPEP § 1207.02 (Rev. 3, August 2005) without reference to any other Office actions, consider whether the Substitute Brief should be entered, and, if entered, provide a complete response to the arguments raised in the Substitute Brief on Appeal. Alternatively, the Examiner should consider reopening prosecution if the Examiner determines that other grounds of rejection remain applicable to the claims of the subject application.

Appeal 2006-3301
Application 10/606,509

Accordingly, the Examiner is required to take appropriate action consistent with current examining practice and procedure to rectify the above-noted matters.

37 C.F.R. § 41.50(a)(2) (2005) applies if a Supplemental Examiner's Answer is written in response to this Remand.

We hereby remand this application to the Examiner, via the Office of a Director of the Technology Center involved, for appropriate action in view of the above comments.

This application, by virtue of its "special" status, requires immediate action.

REMANDED

tf

CORNING INCORPORATED
SP-TI-3-1
CORNING, NY 14831